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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/760,459	01/21/2004	Masato Yamada	247925US2	1407

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OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.
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EXAMINER

RAO, SHEELA S

ART UNIT	PAPER NUMBER
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2125

DATE MAILED: 03/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/760,459	Applicant(s) YAMADA ET AL.	
	Examiner Sheela Rao	Art Unit 2125	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 June 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-13 are presented for examination and are pending

Specification

2. The specification is objected to, as it has not been checked, with regard to spelling and grammatical errors, to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware of in the specification.

3. The specification is further objected to for not providing a clear and definite definition of the claimed feature of the instant invention, i.e. "tooling sheets". In consideration and review of the instant disclosure, the implied definition of tooling sheet is interpreted as a material that is being manipulated, i.e. sheet metal in the manufacturing environment that is cut or etched, etc. Yet at certain instances, i.e. page 3 last paragraph, the tooling sheet seems to be used as a specifications sheet in a processing environment, i.e. a data sheet with tool information or requisition order. The intended definition or usage of a tooling sheet has not been clearly disclosed. Also, on page 4 at line 2, "the preparation of tooling sheets involving generating tooling sheets" is stated, the confusion as to what a tooling sheet is intended to be, is further expanded.

4. Page 4, initially stated at line 1, cites "to resolve the aforementioned problems", prior problems or inconsistencies has not been clearly cited in the preceding pages of the specification. Examiner is not sure what problems existed beforehand nor what problems are being resolved by the instant invention.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-13 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1: "a system for the preparation of tooling sheets" is stated in the preamble, this portion of the instant claim is grammatically awkward and implies that a system of sorts is performing the physical action of preparing tool sheets, which is not possible, this grammatical inconsistency is repeated in dependent claims 2-6. At line 2, "the recommended cutting conditions" is stated, the limitation lacks antecedence and it is not clear as to what conditions have been recommended; at line 3, "the tool body" is stated and lacks proper antecedence; "are recorded" is stated but what is the means of recording and how the recording will be done is not clearly defined. The preamble contains no transitional language such that the Examiner is unable to determine whether the claim is open or closed, i.e. language such as comprising, including, etc. is required. See MPEP 2111.02. At line 5, "with a previously defined method" is stated however no prior method is provided in the instant claim language and this feature lacks proper antecedence.

Claim 3: at line 7, "the designated cutting tools" lacks proper antecedence.

Claim 7: at lines 2-3, "the tool body", "the insert", and "the insert material" all lack proper antecedence; "are recorded" is stated but what the means of recording and how the recording will be done is not clearly defined. The preamble contains no transitional language such that the Examiner is unable to determine whether the claim is open or closed, i.e. language such as comprising, including, etc. is required. See MPEP 2111.02. At line 4, "with a previously defined method" is stated however no prior method is provided in the instant claim language and this feature lacks proper antecedence.

Claim 8: at line 1, "a program for the preparation of tooling sheets" is stated in the preamble, this portion of the instant claim is grammatically awkward and implies that a computer program is performing the physical action of preparing tool sheets which is not possible, this grammatical inconsistency is repeated in dependent claims 9-13. Furthermore, the preamble contains no transitional language such that the Examiner is unable to determine whether the claim is open or closed, i.e. language such as comprising, including, etc. is required. See MPEP 2111.02. At lines 3-4, "the tool body", "the insert", and "the insert material" all lack proper antecedence; "are recorded" is stated but what the means of recording

is and how the recording will be done is not clearly defined; at line 6, "with a previously defined method" is stated however no prior method is provided in the instant claim language and this feature lacks proper antecedence.

In addition to the above stated deficiencies, the limitations of the instant claims lack nexus between the elements of the claimed features. Furthermore, a program as being employed in a system is stated, however, a computing means per se has not been included within the instant claimed limitations to carry out the functions of the system, method, or program.

Claim Rejections

7. No art rejection has been applied due to the inconsistent usage of a tooling sheet and the lack of nexus of the limitations as disclosed in the instant specification and claim language. See *In re Steele*, 49 CCPA 1295, 134 USPQ 292 (1962). When the dependent claims are read in light of the independent claims, the Examiner cannot determine the metes and bounds of the claim language.

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

9. Claims 1-13 are rejected under 35 U.S.C. 102(e) as being anticipated by Sakai, US Patent No. 6,219,586 B1. In the interest of compact prosecution, the reference of prior art by Sakai is being applied. The use of a tooling sheet is interpreted as a specification data sheet.

The patented invention by Sakai teaches of an apparatus and method for managing and distributing design and manufacturing information for the production of components within a factory environment. A CAD/CAM design system and program are used to develop a model of the sheet metal part. Control code based on the part design for generation of a part program for control of the tool, i.e. a punch press or cutting machinery, is used. The system disclosed by Sakai provides the ability to search previous job information based on features and attributes of the sheet metal component. A display system is present for generation and display of a plurality of images of the part as well as displaying the tooling information. The automated system includes a personal computer with a display monitor and input/output devices, i.e. a keyboard, mouse, etc. The patented disclosure includes in the system a network interface for communication means. The reference of prior art teaches of a system, method, program product for the preparation of tooling data for a sheet metal part as claimed by the limitations of the instant invention. For the reasons stated above, the limitations of the claimed invention is taught by the prior art of record; thereby, rendering the instant claims unpatentable.

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sheela Rao whose telephone number is (571) 272-3751. The examiner can normally be reached Monday - Friday from 9:00 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Leo Picard, can be reached on (571) 272-3749.


Any response to this action should be mailed to:

**Commissioner of Patents and Trademarks
Washington, D.C. 20231**

or faxed to:

(703) 305-3718 for Official Communications

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.


Sheela S. Rao
March 11, 2005



**LEO PICARD
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100**